

10-01-02

GP 3456
1632

Express Mail No.: EV110549381US
Attorney Docket: Equine3USNP

IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE

In Re the Application of: Edward L. Squires, Patrick M. McCue and George E. Seidel

Serial Number: 09/744,675

Filed: January 29, 2001

For: Equine System for Non-Surgical Artificial Insemination

Group Art Unit: 3456

Examiner: Wilson, Michael C.

Assignee: Colorado State University through its agent Colorado State
University Research Foundation

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OCT 04 2002

TECH CENTER 1600/2900

LETTER OF TRANSMITTAL

The Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Commissioner:

Enclosed for filing pursuant to the Patent Cooperation Treaty are the following documents:

1. a Response To Election/Restriction under 35 U.S.C. 121 and 372;
2. Certificates of Express Mailing pursuant to 37 C.F.R. 1.10 for the above documents; and
3. this letter of Transmittal and a Postcard Receipt for return to the undersigned.

I have this ____ day of September, 2002, either myself personally or through my direction of staff at this office, deposited all of the items in the above letter of transmittal with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231.

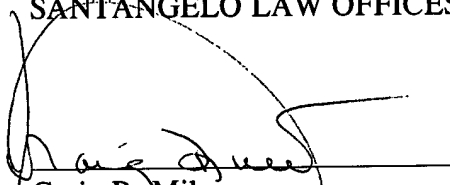
Please stamp and return the enclosed postcard, and **direct all correspondence to me at the indicated address.**

125 South Howes, Third Floor
Fort Collins, CO 80521

Dated this 27 day of September, 2002.

Sincerely,

SANTANGELO LAW OFFICES, P.C.



Craig R. Miles
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University Research Foundation

CERTIFICATE OF EXPRESS MAILING

I, Cheryl A. Swanson, hereby certify to the truth of the following items:

1. I am an employee of Santangelo Law Offices, P.C., 125 South Howes, Third Floor, Fort Collins, Colorado 80521.

2. I have this day deposited the attached Letter of Transmittal and a return receipt postcard with the United States Postal Service as Express Mail for mailing to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Dated this 27 day of September, 2002.

Cheryl A. Swanson
Cheryl A. Swanson



#1
10/4/02

Express Mail No.:EV110549381US
Attorney Docket: Equine3USNP

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Examiner: Wilson, Michael C.

Assignee: Colorado State University through its agent Colorado State University Research Foundation

**RESPONSE TO RESTRICTION REQUIREMENT
UNDER 35 U.S.C. § 121**

In official action, Paper No. 9, mailed August 27, 2002, the Examiner has required restriction in the above-referenced application. The Examiner has set forth claims 15-30, 40-42 as Group I, claims 31-39, 43, 52-58 as Group II, claims 44, 59, 69 as Group III, claims 45-51 and 60 as Group IV, claims 61-67 as Group V, claim 68 as Group VI. A shortened statutory period of one month has been set, making a response to this action due on or by September 27, 2002.

The Applicant, after review of the Examiner's restriction requirement, hereby elects for further prosecution in the present application the invention of Group IV, including claims 45-51 and 60, with traverse.

REMARKS

A first lack of unity under PCT Rule 13.2 (Paper 7) was mailed to applicant on April 24, 2002 setting out Groups I-VI. The applicant elected Group IV (claims 45-58, and 60) for prosecution on the merits. Subsequently, on August 27, 2002, the office mailed a second lack of unity action removing claims 52-58 from Group IV and reassigning such claims to Group II, and requiring the applicant to make a second

election. The applicant provisionally elects Group IV (claims 45-58) of the second election/restriction (Paper 9) with the following traverse.

The subject matter of the application involves and the application is entitled an "Equine System For Non-Surgical Artificial Insemination" which involves insemination of mares with sperm cells obtained from stallions. The invention includes various embodiments including, for example, insemination with either spermatozoa separated into various populations by selected characteristic(s) or with spermatozoa not separated by such characteristics.

It is known in the art that a technical relationship exists between selecting sperm cells for character traits and insemination of female mammals with such sperm cells. See United States Patent 5,135,759, claim 13. ("sorting sperm according to the method of claim 1; and inseminating a female mammal of the same species as the male mammal with the selected sperm in the collecting fluid") (Johnson). Additionally, it is permitted under the rules to have dependent claims to various embodiments of the invention even where the features of the dependent claims could be considered as constituting in themselves an invention. Rule 13.4. Claim 45 of the instant application provides a generic claim to a step of discriminating equine sperm cells by a characteristic as set out in claim 45 which can further include, under the PCT rules, a series of dependent claims for insemination of a mammal with such sperm cells.

Within Group IV, elected by the applicant in the first election/restriction mailed April 24, 2002, the office has not shown that independent claim 45 is not generic to the various embodiments of the invention set out in dependent claims 46-58 as originally restricted and should allow the applicant to prosecute claims 52-58 as part of this group until it can be shown that claim 45 is not generic with regard to insemination of equids with the sperm cells discriminated and collected as set out by claim 45. The complete set of claims (45-58) establish a set of steps that allows sperm cells discriminated and collected to be used for the insemination of equids at least with respect to the various embodiments of the invention described in the description of the specification.

As can be understood, at least since 1991 the office has examined applications that combine the steps of selecting sperm cells and inseminating female mammals. It is not unduly burdensome to perform the search and examination to determine patentability of these useful inventions and the applicant suggests that the office forward the application including all of claims 45-58 to the same group that successfully examined the Johnson patent or to group 1745.

The applicant respectfully requests that the office maintain claims 52-58 in Group IV subject to a search that shows that claim 45 is not generic with respect to this group of claims.

CONCLUSION

The applicant provisionally elects Group IV as set out in the election/restriction mailed on August 27, 2002, with traverse. The applicant specifically requests that claims 52-58 remain a part of Group IV as dependent claims.

Dated this 27 day of September, 2002.

Respectfully Submitted,
SANTANGELO Law Offices, P.C.

By: 

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